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10/091,710	03/05/2002	Juei-Hua Lin	8055/0K324	7465

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EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/091,710

Applicant(s)

LIN, JUEI-HUA

Examiner

Andrew T Piziali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 4-30 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I        Claims 1-4 and 31, drawn to a glass product, classified in class 428, subclass 410.

Group II       Claims 5-30 and 32, drawn to a method for producing a low reflectance, high clarity glass, classified in class 427, subclass 169.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and Group I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. The product can be made by forming the AR surface by vapor deposition, sol gel deposition or by sputtering.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Group I contains claims directed to the following patentably distinct species of the claimed invention:

Species 1, claim 3, drawn to a glass product wherein the product comprises a plane sheet.

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Species 2, claim 4, drawn to a glass product wherein the product comprises a curved sheet.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1 is generic.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. During a telephone conversation with Louis J. DeJuidice on 2/12/2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-4 and 31 and a provisional election was made with traverse to prosecute Species 1, claim 3. Affirmation of

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this election must be made by applicant in replying to this Office action. Claims 4-30 and 32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Rejoinder will be considered upon indication of allowable subject matter pursuant to MPEP 821.04.

### *Drawings*

✓ 10. Figures 1-13 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Figures 1-6 and 9-13 appear to be identical to the Figures in USPN 5,120,605. Figures 1 and 5-11 appear to be identical to the Figures in USPN 4,944,986.

### *Specification*

✓ 11. The disclosure is objected to because of the following informalities: On page 2, line 22, the specification states "Fingerprints, which are a common on glass surfaces..." Appropriate correction is requested.

### *Claim Rejections - 35 USC § 112*

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

✓ 13. Claims 1-3 and 31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

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invention. In claims 1 and 31 the applicant claims “(the) skeletized structure is about 100 to about 400 angstroms.” The claims and specification fail to disclose which dimension (thickness, length, diameter, etc.) has this measurement.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

✓ 15. Claims 1-3 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the applicant claims that the density of the skeletized structure is about 50 to about 70 per 200 nanometers square. It is unclear what structure is occurring “about 50 to about 70 per 200 nanometers square.” The specification discloses on page 12, lines 27-29 that the density is “granule density.” It is not clear what a granule density comprises. The figures do not clearly show any grains. Figure 4 shows that the surface of the film is rough. Is the roughness considered to be granular by the applicant?

In claims 1 and 31 the applicant claims “(the) skeletized structure has “openings of about 100 to about 200 angstroms.” The dimension that the claim is referring to is unclear. The specification appears to disclose that the opening measurements are in terms of length (page 3, lines 26-28). Appropriate correction is requested.

In claims 1 and 31 the applicant claims “(the) skeletized structure is about 100 to about 400 angstroms.” The dimension that the claim is referring to is unknown.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1-3 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,944,986 to Zuel.

Zuel discloses a glass product identical to the currently claimed glass product (see entire document). Zuel discloses that the skeletized structure may have openings of between about 200 to 600 angstroms (column 2, lines 12-22), which is considered to read on the currently claimed skeletized structure having openings of about 100 to about 200 angstroms. Zuel does not mention the specific density of the skeletized structure or if the skeletized structure is about 100 to about 400 angstroms, but considering the substantially identical method disclosed by Zuel (column 6, line 11 through column 7, line 50), compared to the method disclosed by the current applicants, it appears that the glass product of Zuel possesses the claimed skeletized structure.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to

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obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

18. Claims 1-3 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,120,605 to Zuel et al.

Zuel et al discloses a glass product identical to the currently claimed glass product (see entire document). Zuel et al discloses that the skeletized structure may have openings of between about 200 to 600 angstroms (column 2, lines 17-25), which is considered to read on the currently claimed skeletized structure having openings of about 100 to about 200 angstroms. Zuel et al does not mention the specific density of the skeletized structure or if the skeletized structure is about 100 to about 400 angstroms, but considering the substantially identical method disclosed by Zuel et al (column 6, line 3 through column 7, line 25), compared to the method disclosed by the current applicants, it appears that the glass product of Zuel et al possesses the claimed skeletized structure.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Piziali whose telephone number is (703) 306-0145. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5665.



Andrew T Piziali  
Examiner  
Art Unit 1775

atp  
February 12, 2003



DEBORAH JONES

SUPERVISORY PATENT EXAMINER